

Application Number 10/693,008

Amendment in Response to Office Action mailed November 22, 2005

REMARKS

This paper is responsive to the Final Office Action dated November 22, 2005. Claims 1-32 are pending.

Claim Rejection Under 35 U.S.C. § 102

In the Final Office Action, the Examiner rejected claims 1-5, 8, 12-16, 22-26, 28-30 and 32 under 35 U.S.C. 102(a) as being anticipated by Lebel et al. (US2003/0065308). Applicants respectfully traverse the rejection. Lebel et al. (Lebel) fails to disclose each and every feature of the claimed invention, as required by 35 U.S.C. 102(b), and provides no teaching that would have suggested the desirability of modification to include such features.

For example, Lebel fails to teach or suggest disabling a display in a programmer for a medical device during activation of telemetry circuitry in the programmer to reduce electrical interference, as recited by Applicants' independent claims 1, 12, 24, 28 and 32. On the contrary, Lebel describes disabling a backlight used to illuminate a display in low light level conditions. In the Final Office Action, the Examiner asserted that in the "broadest reasonable interpretation," the display described in Lebel includes a backlight because it too provides visual information to the user.

Applicant respectfully submits that the Examiner has misinterpreted the scope and content of the Lebel reference. Contrary to the Examiner's assertion, the display described by Lebel does not include a backlight. Instead, the backlight illuminates the display during low light level conditions when the display cannot be readily viewed (Lebel, [0258]). The display and backlight are separate and distinct components within the Lebel reference. Applicants refer the Examiner to FIG. 4a of Lebel, which clearly illustrates that the display (LCD module 694) and the backlight (EL Backlight 806) within the Lebel device are separate components that receive entirely separate control signals. For example, the LCD module receives signals to drive the display (Lebel, [0226]). The backlight receives signals to enable the backlight and to turn the backlight on and off when enabled (Lebel, [0257]). Based on the teachings of Lebel, the backlight is not included within the display, but instead comprises a completely separate component from the display. For this reason, Applicants respectfully disagree with the Examiner's "broadest reasonable interpretation" of the Lebel reference.

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The Examiner stated that turning the backlight on constitutes enabling the display and turning the backlight off constitutes disabling the display. However, this interpretation is inconsistent with the actual requirements of Applicants' claims, which require enabling a display, and not a backlight associated with a display. Applicants note that a display may be enabled even when a backlight is not enabled. As mentioned above, a backlight merely serves to illuminate the contents of the display to improve visibility. The state of the backlight does not control the operation of the display. On the contrary, in ordinary lighting conditions, the contents presented by a display can be readily viewed without activation of a backlight.

In order to support an anticipation rejection under 35 U.S.C. 102(b), it is well established that a prior art reference must disclose each and every element of a claim. This well known rule of law is commonly referred to as the "all-elements rule."¹ If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. 102(b) is improper.²

Lebel fails to disclose all of the limitations set forth in claims 1-5, 8, 12-16, 22-26, 28-30 and 32. For at least these reasons, the Examiner has failed to establish a prima facie case for anticipation of Applicant's claims 1-5, 8, 12-16, 22-26, 28-30 and 32 under 35 U.S.C. 102(b). Applicants request withdrawal of this rejection.

Claim Rejection Under 35 U.S.C. § 103

In the Final Office Action, the Examiner rejected claims 6, 7, 9, 17-21, 27 and 31 under 35 U.S.C. 103(a) as being unpatentable over Lebel in view of Stanton et al. (US 6,249,703) and claim 10 under 35 U.S.C. 103(a) as being unpatentable over Lebel in view of Stanton et al. (Stanton) and further in view of Stein et al. (US 2004/0230247). Applicants respectfully traverse the rejection. The applied references fail to disclose or suggest the inventions defined by Applicants' claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

¹ See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (CAFC 1986) ("it is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention").

² *Id.* See also *Lewmar Marine, Inc. v. Barent, Inc.* 827 F.2d 744, 3 USPQ2d 1766 (CAFC 1987); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (CAFC 1990); *C.R. Bard, Inc. v. MP Systems, Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (CAFC 1998); *Oney v. Ratliff*, 182 F.3d 893, 51 USPQ2d 1697 (CAFC 1999); *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 57 USPQ2d 1057 (CAFC 2000).

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Lebel fails to describe all of the features of Applicants' independent claims 1, 12, 24, 28 and 32. As described above, Lebel fails to teach disabling a display in a programmer for a medical device during activation of telemetry circuitry in the programmer to reduce electrical interference. Instead, Lebel describes disabling a backlight used to illuminate a display during low light conditions. The backlight is not included in the display and the state of the backlight does not control the operation of the display. Stanton and Stein, either singularly or in combination, provide no teaching capable of overcoming the deficiencies of Lebel.

Moreover, Applicants' claims 6, 7, 17, 18, 27 and 31 recite an internal and an external antenna included in the programmer and enabling the display when the external antenna is in use and disabling the display when the internal antenna is in use. Hence, display control differentiates between use of the internal antenna or the external antenna. The Examiner concluded that it would have been obvious to a person of ordinary skill in the art to combine the internal antenna and external antenna taught in Stanton with the programmer taught in Lebel so the main body of the programmer can be seen and operated while the external antenna is in contact with the body.

Yet, Stanton fails to make any correlation between the type of antenna being used and whether another component of the programmer, such as a display, is enabled or disabled. Furthermore, as described above, Lebel fails to describe disabling a display during telemetry with an internal antenna. Therefore, even if the external and internal antennas of the Stanton reference were included in the programmer of the Lebel reference, it would not have resulted in Applicants' invention as claimed. Instead, the Lebel programmer would disable a backlight, used to illuminate a display for improved visibility in poor lighting conditions, when performing telemetry with an internal antenna. In addition, to the extent an internal antenna or external antenna were incorporated in the Lebel programmer per Stanton, there would have been no suggestion of enabling the backlight, much less a display, during use of one antenna but not the other. Neither of the references provide any suggestion of enabling a display or a backlight when performing telemetry with an external antenna.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicants' claims 6, 7, 9, 10, 17-21, 27 and 31 under 35 U.S.C. 103(a). Applicants request withdrawal of this rejection.

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CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed agent to discuss this application.

Date:

By:

Feb. 22, 2006

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